

REMARKS

I. Formalities

Applicant thanks the Examiner for initialing and returning a copy of the Form PTO-1449 submitted with the Information Disclosure Statement filed on July 29, 2003.

However, the Examiner still has not indicated whether the Formal Drawings filed on June 9, 2000 are accepted, as requested by Applicant in the Amendment Under 37 C.F.R. § 1.111 filed on May 10, 2005. Applicant respectfully requests that the Examiner acknowledge and approve the aforementioned Formal Drawings.

II. Status of the Application

Claims 1-8 and 11-30 are all the claims pending in the Application, with claims 1, 16, 19, 27 and 29 being in independent form. Claims 1-8 and 11-30 have been rejected.

The present Response addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

III. Claim Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-8 and 10-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,191,611 to Lang (hereinafter "Lang"), in view of U.S. Patent No. 4,907,268 to Bosen *et al.* (hereinafter "Bosen"), in view of European Patent 0 878 780 A2 to Whytock (hereinafter "Whytock"), in view U.S. Patent No. 5,948,103 to Fukuzaki (hereinafter "Fukuzaki") and further in view of U.S. Patent No. 4,993,068 to Piosenka (hereinafter "Piosenka"). Applicant respectfully traverses these rejections for *at least* the independent reasons stated below.

In order for the Examiner to maintain the above rejection under 35 U.S.C. §103, Lang, Bosen, Whytock, Fukuzaki, Piosenka, or some combination thereof, must teach or suggest all of the recitations of claims 1-8 and 10-30. Applicant respectfully submits that neither Lang, Bosen, Whytock, Fukuzaki, Piosenka, nor any combination thereof, teaches or suggests all of the recitations of claims 1-8 and 10-30.

A. Independent Claim 1

The Examiner acknowledges that neither Lang, Bosen, nor any combination thereof, teaches or suggests the feature of a third storage unit which stores a physical characteristic data file which pre-stores data on the physical characteristics of a certified operator. (07/06/05 Office Action, page 5). The Examiner also acknowledges that neither Lang, Bosen, nor any combination thereof, teaches or suggests the feature of a comparison between data on physical characteristics of an operator obtained by a physical characteristic data obtaining unit and the data on the physical characteristics stored in said third storage unit. (07/06/05 Office Action, page 5). Nonetheless, the grounds of rejection rely on Whytock as allegedly teaching or suggesting these features. Further, the grounds of rejection allege that it would have been obvious to one of ordinary skill in the art to combine the teachings of Lang and Bosen with those of Whytock “because this provides increased security techniques that are efficient and highly accurate as well as difficult to compromise.”

Applicant respectfully disagrees with the grounds of rejection. First, the grounds of rejection have failed to provide the requisite factual basis to support the bald allegation that one of ordinary skill would have been motivated to combine the teachings of Lang and Bosen with

those of Whytock, to arrive at the invention recited in claim 1, “because this provides increased security techniques that are efficient and highly accurate as well as difficult to compromise.” In fact, the grounds of rejection do not offer any evidentiary support whatsoever for this alleged motivation in the objective teachings of the prior art.

It is well settled that mere allegations by the Examiner that certain differences between the claimed subject matter and the prior art are obvious do not create a presumption of unpatentability. (*In re Soli*, 317 F.2d 941, 137 USPQ 797 (CCPA 1963)). To the contrary, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. (*In re Lahu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984); *see* MPEP §2143.01). In contrast to the requirements of the MPEP and established precedent, the grounds of rejection have not identified any objective teaching in Lang, Bosen, or Whytock that suggests combining these references because this combination would provide increased security techniques that are efficient and highly accurate as well as difficult to compromise, as alleged.

Moreover, the grounds of rejection have not identified any objective teaching in Lang, Bosen, or Whytock that even remotely suggests the desirability of making the specific combination of elements recited in claim 1. Indeed, the mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modifications. (MPEP §2143.01). Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion

or teaching of the desirability of making the specific combination that was made by the applicant. (*In re Kotzab*, 55 USPQ2d at 1316).

Secondly, the motivation cited by the Office Action is simply “because this provides increased security techniques that are efficient and highly accurate as well as difficult to compromise.” Such a motivation, as a matter of law, is insufficient. It evidences impermissible hindsight application and reasoning on the part of the Patent Office. By definition, every patented invention possesses some functional utility. Also, it has long been said that any new patented article is simply a novel collection of known elements. Using the reasoning applied by the Office Action, all patent applications could be rejected as obvious, on the basis that all the claimed elements are known and the motivation to combine them is simply to achieve the functional utility of the invention.

Furthermore, in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a) the Examiner must show that Lang, Bosen, Whytock, Fukuzaki, Piosenka, or some combination thereof, teaches or suggests all of the recitations of claim 1. (*See* MPEP § 2143).

Independent claim 1 recites a specific combination including (among other things):

said controller executes the program stored
in said memory to:
...determine that said system is operated by a
certified operator only when said
medium verification device verifies
that said first recording medium is a
certified medium, and all three of the
data on physical characteristics of an
operator obtained by said physical
characteristic data obtaining unit, the
data regarding the physical,
characteristics of an operator which
said data reader has read from said
first recording medium, and the data on
the physical characteristics stored in
said third storage unit, correspond to
one another...

The grounds of rejection acknowledge that neither Lang, Bosen, Whytock, Fukuzaki, nor any combination thereof, teaches or suggests the above feature. Nevertheless, the grounds of rejection apply the Piosenka reference, alleging that Figure 3b of Piosenka teaches a credential being verified as certified and proceeding to a biometric analysis phase of authentication. The grounds of rejection also allege that it would have been obvious to one of ordinary skill in the art to combine the teachings of Lang, Bosen, Whytock, and Fukuzaki, with those of Piosenka, to arrive at the invention recited in claim 1, and allege that the motivation for doing so is "because stacking verification procedures obviously augments the security of the organization."

Applicant respectfully disagrees with the grounds of rejection. Neither Lang, Bosen, Whytock, Fukuzaki, Piosenka, nor any combination thereof, teaches or suggests the feature of determining that a system is operated by a certified operator only when a medium verification

device verifies that a first recording medium is a certified medium, and all three of (1) the data on physical characteristics of an operator obtained by a physical characteristic data obtaining unit, (2) the data regarding the physical, characteristics of an operator which a data reader has read from said first recording medium, and (3) the data on the physical characteristics stored in said third storage unit, correspond to one another, as recited in claim 1.

Even if Piosenka did teach the feature of a credential being verified as certified and proceeding to a biometric analysis phase of authentication, as alleged by the grounds of rejection (which Applicant submits that Piosenka does not), the grounds of rejection have not pointed to any specific portion of Piosenka that teaches or suggests determining that a system is operated by a certified operator only when a medium verification device verifies that a first recording medium is a certified medium, and all three of (1) the data on physical characteristics of an operator obtained by a physical characteristic data obtaining unit, (2) the data regarding the physical, characteristics of an operator which a data reader has read from said first recording medium, and (3) the data on the physical characteristics stored in said third storage unit, correspond to one another, as required by claim 1. In fact, the grounds of rejection have failed to identify any objective teaching in any of the cited references that teaches or suggests this feature.

Accordingly, for *at least* these reasons, Applicant submits that the grounds of rejection have not even established a *prima facie* case of obviousness under 35 U.S.C. § 103(a). (*See* MPEP § 2143).

In addition, the grounds of rejection have failed to provide the requisite factual basis to support the bald allegation that one of ordinary skill would have been motivated to combine the

teachings of Lang, Bosen, Whytock, and Fukuzaki, with those of Piosenka, to arrive at the present invention “because stacking verification procedures obviously augments the security of the organization.” To the contrary, the grounds of rejection do not offer any evidence whatsoever to support this alleged motivation to combine the cited references.

As already discussed above, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. (*In re Lalu*, 747 F.2d 703, 223 USPQ 1257 (Fed. Cir. 1984); *see* MPEP §2143.01). In contrast to the requirements of the MPEP and established precedent, the grounds of rejection have not identified any objective teaching in Lang, Bosen, Whytock, Fukuzaki or Piosenka that suggests combining these references because this combination would stack verification procedures which obviously augments the security of the organization, as alleged.

Further, the grounds of rejection have not identified any objective teaching in Lang, Bosen, Whytock, Fukuzaki, or Piosenka that even remotely suggests the desirability of making the specific combination of elements recited in claim 1. Indeed, as discussed above, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. (*In re Kotzab*, 55 USPQ2d at 1316).

However, the grounds of rejection have not identified any motivation for combining the teachings of Lang, Bosen, Whytock, and Fukuzaki, with those of Piosenka, to make the specific

combination recited in claim 1 including (among other things) an electronic data management system which determines that a system is operated by a certified operator only when a medium verification device verifies that a first recording medium is a certified medium, and all three of (1) the data on physical characteristics of an operator obtained by a physical characteristic data obtaining unit, (2) the data regarding the physical, characteristics of an operator which a data reader has read from said first recording medium, and (3) the data on the physical characteristics stored in said third storage unit, correspond to one another.

In fact, for *at least* the reasons set forth in the Amendment under 37 C.F.R. § 1.111, filed on May 10, 2005, Whytock expressly teaches away from the combination proposed in the grounds of rejection. More particularly, Whytock teaches that that information uploaded from a smart card may be used as an alternative to downloading information regarding the user's iris from the host computer 30. (Column 3, line 55 – column 4, line 11). As a result, Whytock expressly teaches away from the feature of determining whether all three of the data on physical characteristics of an operator obtained by said physical characteristic data obtaining unit, the data regarding the physical, characteristics of an operator which said data reader has read from said first recording medium, and the data on the physical characteristics stored in said third storage unit, correspond to one another, as recited in claim 1. Since the Examiner has failed to respond to the arguments advanced in this regard with the Amendment filed on May 10, 2005, these arguments remain unrebutted and, therefore, claim 1 is patentable over the cited references for *at least* the reasons already of record.

What is more, the motivation cited by the Office Action is merely “because stacking verification procedures obviously augments the security of the organization.” As explained above, such a motivation, as a matter of law, is insufficient and it evidences impermissible hindsight application and reasoning on the part of the Patent Office. By definition, every patented invention possesses some functional utility. Also, it has long been said that any new patented article is simply a novel collection of known elements. However, as already discussed, using the reasoning applied by the Office Action, all patent applications could be rejected as obvious, on the basis that all the claimed elements are known and the motivation to combine them is simply to achieve the functional utility of the invention.

Accordingly, Applicant respectfully submits that independent claim 1 is patentable over Lang, Bosen, Whytock, Fukuzaki, Piosenka, nor any combination thereof, for *at least* these independent reasons. Further, Applicant respectfully submits that the dependent claims 2-15 are allowable, *at least* by virtue of their dependency on independent claim 1. Thus, Applicant respectfully requests that the Examiner withdraw these rejections.

B. Independent Claim 16

Independent claim 16 recites a specific combination including (among other things):

...user verification means for determining that an operator is certified when all three of the data relating to the physical characteristics of the operator obtained by said physical characteristic data obtaining means, the data regarding the physical characteristics of an operator which said medium reading means has read from said recording medium, and the data relating to the physical characteristics stored in said physical characteristic data storage means correspond to one another...

In view of the similarity between the requirements of claim 16 and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that arguments analogous to the foregoing arguments as to the patentability of independent claim 1 demonstrate the patentability of claim 16. As such, it is respectfully submitted that claim 16 is patentably distinguishable over Lang, Bosen, Whytock, Fukuzaki, Piosenka, and any combination thereof, for *at least* reasons analogous to those presented above. Further, Applicant respectfully submits that the dependent claims 17-18 are allowable over the applied references *at least* by virtue of their dependency on claim 16. Accordingly, the allowance of these claims is respectfully solicited of the Examiner.

C. Independent Claim 19

Independent claim 19 recites a specific combination including (among other things):

...discriminating that a certified operator operates said system when all three of the obtained data relating to the physical characteristics of an operator, the pre-stored data relating to physical characteristics of the certified operator, and the data regarding the physical characteristics of an operator read from said recording medium correspond to one another...

In view of the similarity between the requirements of claim 19 and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that arguments analogous to the foregoing arguments as to the patentability of independent claim 1 demonstrate the patentability of claim 19. As such, it is respectfully submitted that claim 19 is patentably distinguishable over Lang, Bosen, Whytock, Fukuzaki, Piosenka, and any combination thereof, for *at least* reasons analogous to those presented above. Further, Applicant

respectfully submits that the dependent claims 20-26 are allowable over the applied references *at least* by virtue of their dependency on claim 19. Accordingly, the allowance of these claims is respectfully solicited of the Examiner.

D. Independent Claim 27

Independent claim 27 recites a specific combination including (among other things):

...obtaining data relating to physical characteristics of an operator, and discriminating that a certified operator operates said system when all three of the obtained data relating to the physical characteristics of an operator, the pre-stored data relating to physical characteristics of the certified operator, and the data regarding the physical characteristics of an operator read from said recording medium correspond to one another...

In view of the similarity between the requirements of claim 27 and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that arguments analogous to the foregoing arguments as to the patentability of independent claim 1 demonstrate the patentability of claim 27. As such, it is respectfully submitted that claim 27 is patentably distinguishable over Lang, Bosen, Whytock, Fukuzaki, Piosenka, and any combination thereof, for *at least* reasons analogous to those presented above. Further, Applicant respectfully submits that the dependent claim 28 is allowable over the applied references *at least* by virtue of its dependency on claim 27. Accordingly, the allowance of these claims is respectfully solicited of the Examiner.

E. Independent Claim 29

Independent claim 29 recites a specific combination including (among other things):

...a segment for obtaining data relating to physical characteristics of an operator, and discriminating that an operator is a certified operator when all three of the obtained data relating to the physical characteristics of an operator, the pre-stored data relating to physical characteristics of the certified operator, and the data regarding the physical characteristics of an operator read from said recording medium correspond to one another...

In view of the similarity between the requirements of claim 29 and the requirements discussed above with respect to independent claim 1, Applicant respectfully submits that arguments analogous to the foregoing arguments as to the patentability of independent claim 1 demonstrate the patentability of claim 29. As such, it is respectfully submitted that claim 29 is patentably distinguishable over Lang, Bosen, Whytock, Fukuzaki, Piosenka, and any combination thereof, for *at least* reasons analogous to those presented above. Further, Applicant respectfully submits that the dependent claim 30 is allowable over the applied references *at least* by virtue of its dependency on claim 29. Accordingly, the allowance of these claims is respectfully solicited of the Examiner.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Response Under 37 C.F.R. § 1.116
U.S. Serial No. 09/590,686

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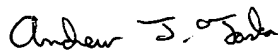
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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CUSTOMER NUMBER



Andrew J. Taska
Registration No. 54,666

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